

## REMARKS

The Examiner is thanked for the courtesy of a telephone interview on June 17-18, 2003.

This Amendment responds to the Office Action mailed February 21, 2003. Claims 46-63 and 82-89 are pending. Claims 46, 55, 82 and 85 are independent.

The Examiner's attention is directed to the discussion of chargeback systems in section 2.5 hereof. Applicant believes that chargeback systems are closer to the present invention than the references relied upon by the Examiner.

### 1. SUMMARY OF THE INVENTION

The present invention relates to an automated assisted negotiation system that provides a structured process for a complainer and a complaine to resolve a problem (page 4, line 4). If resolution cannot be achieved with the present system, the system can forward a well-formed record of the automated proceedings to a human dispute resolver for their services (page 6, line 22 – page 7, line 2).

Advantages of an automated assisted negotiation system are that

- the system is inexpensive compared with engaging a human dispute resolution professional;
- the system enables a complainer to use its dispute resolution procedure even if the complainer is unaware of dispute resolution methodology; and
- the system serves the complainer by providing portions of the complaine's predefined information to the complainer at the times when the information is relevant to the complainer

More specifically, the assisted negotiation system can be implemented as a web site interacting with a visiting complainer (page 5, lines 22-23). The system provides a complaint form to the complainer enabling the complainer to provide pertinent information about the complainer and the problem (page 7, line 11).

After the complainer enters information about the type of problem (page 7, line 15 - page 8, line 16), the system determines which portion of information previously supplied by the complaine is relevant, and supplies the relevant information to the complainer (page 9, line 22 –

page 10, line 2; page 10, lines 18-21). This is substantially more convenient than the typical frequently asked questions (FAQ) approach, which requires that the complainer (a) guess that there is relevant information on the website, and (b) try to find the relevant information.

The assisted negotiation system encourages the complainer to vent their emotions, which is an important feature of dispute resolution, and prepares a summary of the emotional information for inclusion in the complaint summary (page 6, lines 7-8). Humans are built to react emotionally before they react intellectually; accordingly, it is well-known among dispute resolution professionals that giving parties an opportunity to express their feelings promotes reaching agreement, i.e., resolving the dispute. It is also well-known among dispute resolution professionals that a person who has an opportunity to be heard is more likely to be satisfied with a dispute resolution process, even if the outcome is adverse to the person. Thus, even if the system does not make decisions based on the emotional information provided by the complainer, the mere collection of the information and “reflecting back” of the information in summary form has a positive effect on the complainer, i.e., makes the complainer “feel heard”.

The assisted negotiation system also suggests at least one remedy to the complainer, based on the nature of the complainer’s problem (page 10, lines 5-6). The at least one remedy is selected from a set of predefined remedies. Each complaineer may provide its own set of acceptable remedies for various types of problems (page 10, lines 19-21). The system includes the remedy(s) chosen by the complainer in the prepared complaint summary (page 10, lines 8-9).

After the complainer approves the prepared complaint, including the actual name of the complainer (page 7, lines 15-16), the system forwards the prepared complaint to the complaineer (page 10, lines 11-12).

#### 1.1 CLAIM 46 -- PROVIDING SELECTED DATA

Claim 46 relates to a method of processing a complaint by a computer. Initial information is received from a complainer including information identifying the complainer. Selected data is chosen from data previously received from a complaineer based on the initial information from the complainer, and the selected data is provided to the complainer. Additional information is received from the complainer. The complaint is prepared based on the initial information and the additional information, and presented to the complainer for approval to generate an approved

complaint. The approved complaint, including the information identifying the complainer, is forwarded to the complainee.

Claim 46 and its dependent claims 47-54 were rejected as being obvious over combinations including the Sloo and Online Resolution references.

#### 1.2 CLAIM 55 -- EMOTIONAL STATE INFORMATION

Claim 55 relates to a method of processing a complaint by a computer. Information is received from a complainer including information describing a problem, information relating to an emotional state of the complainer, and information identifying the complainer. The complaint is automatically prepared including emotional state information based on the information received from the complainer, and presented to the complainer for approval to generate an approved complaint. The approved complaint is automatically forwarded to the complainee.

Claim 55 and its dependent claims 56-63 were rejected as being obvious over combinations including the Sloo, Online Resolution and Eisen references.

#### 1.3 CLAIM 82 -- RESPONDEE DETERMINATION

Claim 82 relates to a method of processing a complaint by a computer. A complaint approved by the complainer is forwarded to a first complainee. It is detected that the first complainee caused the complaint to be forwarded to a second complainee, and that the second complainee indicated that the complaint should be forwarded to the first complainee. A procedure is initiated to determine which of the first complainee and second complainee is responsible for substantively responding to the complaint.

Claim 82 was not rejected in view of any prior art references.

#### 1.4 CLAIM 85 -- REMEDY SUGGESTION

Claim 85 relates to a method of processing a complaint by a computer. Information is received from a complainer including information relating to a problem experienced by the complainer and information identifying the complainer. At least one selected remedy is chosen

from a predetermined set of remedies based on the information from the complainer. The predetermined set of remedies is provided from the complaine. The at least one selected remedy is suggested to the complainer, and a response to the at least one suggested remedy is received. The complaint is prepared based on the information and the response received from the complainer, and the prepared complaint is presented to the complainer for approval to generate an approved complaint. The approved complaint is forwarded to the complaine.

Claim 85 and its dependent claims 86-89 were rejected as being obvious over combinations including the Sloo and Thiessen references.

## 2. SUMMARY OF REFERENCES CITED

### 2.1 SLOO

U.S. Patent No. 5,895,450 (Sloo) was used in rejections of claims 46-63 and 85-89. Applicant disclosed Sloo to the Patent Office (Information Disclosure Statement mailed October 20, 2000, PTO Form 1449 Reference AA).

#### 2.1.1 DESCRIPTION OF SLOO

Sloo discloses a system for handling complaints that informs other consumers about the complaints (column 1, line 23) and rewards good conduct while punishing bad conduct in complaint resolution (column 1, lines 44-50).

Sloo's system prompts a complainer to enter a detailed complaint including identifying information – the user's phone number and e-mail address – keywords summarizing the complaint, and a requested remedy (column 4, lines 49-52; column 4, line 63 – column 5, line 2). The identifying information is used to track the complainer's conduct (column 5, lines 3-6). The system sends the complaint to the complainer by e-mail, receives a confirmation including any corrections and, as verification, compares the confirmation to the detailed complaint (column 5, lines 20-29).

The system creates a unique e-mail address for the complainer, to be used by the complainer and complainee so they can privately negotiate a settlement by communicating directly with each other (column 5, lines 11-19; column 7, lines 33-35 and 42-65).

Then, Sloo's system sends to the complainee the detailed complaint, the suggested remedy and the complainer's unique e-mail address (column 5, lines 38-45). Sloo's system does not disclose the name of the complainer to the complainee; the anonymity encourages complaint filing (column 6, lines 43-46).

If direct negotiation between the complainer and the complainee does not yield a resolution, the complaint can be referred to a jury (column 8, lines 5-45) or to a computer program that decides the complaint (column 9, line 57 – column 10, line 14).

Sloo's system may collect satisfaction data from the complainer and complainee to assist the system in its automated decision-making (column 14, lines 45-56; column 15, lines 21-50). Satisfaction data is made available to the public (column 14, lines 63-64; column 15, lines 1-3).

Sloo's system posts a notice of the complaint in a public database including the keywords or abbreviated description of the complaint entered by the user (column 5, lines 3-6). The public database is searchable by the public (column 5, lines 57-65)

## 2.1.2 DISTINCTIONS BETWEEN SLOO AND THE PRESENT INVENTION

Sloo's system is essentially a public bulletin board for posting anonymous complaints. Sloo's system does not assist parties in negotiating, rather, Sloo forces the parties into direct e-mail negotiation. Sloo tracks the behavior of the complainer and complainee to monitor whether they are using the system properly, not to assist in resolving the complaint.

### 2.1.2.1 DISTINCTIONS BETWEEN SLOO AND CLAIM 46

Sloo fails to disclose or suggest the step of providing selected data to the complainer, the selected data being chosen from data previously received from a complainee based on the initial information from the complainer, as specifically recited in claim 46. Instead, Sloo forces the complainer to guess that a complainee might have provided data relating to complaint resolution,

and then the complainer must hunt the hoped-for appropriate data. In short, Sloo's system is more burdensome for the complainer than the claimed invention.

Sloo also fails to disclose the step of forwarding the approved complaint, including the information identifying the complainer, to the complainee, as specifically recited in claim 46. This is because Sloo preserves the anonymity of the complainer, to encourage complaining. In contrast, the invention of claim 46 assists parties in dispute resolution, and so discloses the identity of the complainer.

#### 2.1.2.2          DISTINCTIONS BETWEEN SLOO AND CLAIM 55

Sloo fails to disclose or suggest receiving emotional state information from a complainer and including the emotional state information in the complaint, as required by claim 55. Instead, Sloo discloses collecting "satisfaction data" to improve the system's performance. That is, Sloo's satisfaction data is used by the system and made available to the public, but is not explicitly sent from the complainer to the complainee, as required by claim 55, apparently because the satisfaction data is collected after the complainer has filed the complaint. In contrast, claim 55 enables the complainer to emotionally vent prior to sending a complaint to a complainee, which assists in dispute resolution.

#### 2.1.2.3          DISTINCTIONS BETWEEN SLOO AND CLAIM 85

Sloo fails to disclose or suggest choosing at least one selected remedy from a predetermined set of remedies from a complainee based on the information from the complainer, and further fails to disclose suggesting the at least one selected remedy to the complainer and preparing a complaint based on a complainer's response to the at least one selected remedy. Instead, Sloo requires that the complainer specify a remedy when submitting complaint information. Sloo assumes that complainers understand the complaint resolution process and will form reasonable expectations, which is unrealistic, as most people are not well versed in complaint handling procedures and may have little or no basis for forming reasonable expectations. In contrast, the invention of claim 85 enables complainees to help complainers

form reasonable expectations by letting the complainer select from a set of remedies, which is much easier than describing a remedy *ab initio*.

## 2.2 ONLINE RESOLUTION

An Online Resolution Press Release, "Online Mediation Offered for Resolving E-Commerce Disputes" ("Online Resolution") was used in rejections of claims 46-63.

### 2.2.1 DESCRIPTION OF ONLINE RESOLUTION

Online Resolution discloses a way for mediators to use the Internet for mediating disputes between people who will never meet (page 2, paragraph 1).

A complainer goes to a web site, fills out a form describing their complaint and submits the complaint by e-mail to the Mediation Information and Resource Center (MIRC). MIRC contacts the complaine, and if the complaine agrees to mediation, MIRC selects a human mediator. The complainer, complaine and human mediator then communicate by e-mail to solve the problem (page 1, last paragraph). Fees range from \$50 to \$100 per hour of mediator time (page 1, penultimate paragraph).

If in-person negotiation is desired, MIRC will provide names of mediators in the geographic area of the complainer and complaine (page 2, fourth paragraph).

Online Resolution quotes John Helie and Colin Rule. With regard to online mediation, Helie states (page 2, second paragraph),

Yes, you don't have the nonverbal cues, but the face-to-face in most cases is overrated and not necessary.

Rule states that just as body language matters in negotiation, politeness matters in e-mail mediations (page 2, sixth paragraph), and notes (page 2, seventh paragraph),

Emotions are a big part of the mediation process.

## 2.2.2 DISTINCTIONS BETWEEN ONLINE RESOLUTION AND THE PRESENT INVENTION

Online Resolution discloses a completely manual dispute resolution process. Automation is used simply as an e-mail communication channel between the parties, to avoid the need for a face-to-face meeting.

In view of Helie's comments, the reasonable interpretation of Rule's comment is that online dispute resolution helps eliminate emotions from the resolution process, thereby simplifying the process.

### 2.2.2.1 DISTINCTIONS BETWEEN ONLINE RESOLUTION AND CLAIM 46

Online Resolution fails to disclose or suggest the step of providing selected data to the complainer, the selected data being chosen from data previously received from a complaineer based on the initial information from the complainer, as specifically recited in claim 46. Instead, Online Resolution assumes that a human mediator will ensure that the complaineer tells the complainer of data relevant to complaint resolution. In short, Online Resolution fails to disclose automating complaint resolution as required in claim 46, and instead presents a way for human mediators to serve in more cases.

### 2.2.2.2 DISTINCTIONS BETWEEN ONLINE RESOLUTION AND CLAIM 55

Online Resolution fails to disclose or suggest receiving emotional state information from a complainer and including the emotional state information in the complaint, as required by claim 55. Instead, Online Resolution indicates that an online process helps eliminate emotions from the dispute resolution process. However, emotions are a visceral human reaction, and there is no explanation of how using the Internet "rewires" people to eliminate their visceral reactions.

Online Resolution teaches that a face-to-face meeting can be part of the process when the online process is not enough, i.e., traditional in-person completely manual mediation using a human mediator. In contrast, the system of claim 55 does not require a human mediator, and instead facilitates normal human behavior, i.e., emoting, as part of the dispute resolution process.



## 2.3 EISEN

Eisen, "Are We Ready for Mediation in Cyberspace" was used in rejections of claims 47, 49, 51 and 55-63.

### 2.3.1 DESCRIPTION OF EISEN

Eisen discloses online mediation via e-mail that passes through a human mediator (page 2, last paragraph; page 3, first and second paragraphs) with documents posted on a website (page 2, second paragraph). Eisen argues that such online mediation is unfeasible until technology progresses to replicate face-to-face interactions (page 1, abstract; page 2, third paragraph; page 15, second paragraph).

Eisen points out that the written nature of online mediation will create communication breakdowns (page 2, first paragraph).

Eisen notes that the anonymity of the Internet is a main attraction, but that this anonymity creates an authentication problem (page 7, second paragraph).

Eisen is consistently skeptical about the efficacy of online mediation due to the constraints of an online process:

One's ability to express emotion online is different; cyberspace currently " 'comes without all five senses attached.' " Oral expressions of feelings in a face-to-face setting have a richer and more meaningful context than written expressions of feelings in an E-mail exchange. (page 2, last paragraph)

The substitution of E-mail for dialogue, for example, makes it difficult to give any weight to emotion in mediation. (page 5, second paragraph)

The opportunity to tell one's version of the case directly to the opposing party and to express accompanying emotions can be cathartic for mediation participants. ... I am extremely doubtful that catharsis could happen in any setting other than a face-to-face conversation. (page 5, second-third paragraph)

The emotional impact of articulating one's position is attenuated if one is separated from the listener by an electronic distance. If an element of the catharsis is not simply to tell one's story, but also to

have an effect on the listener, then online mediation seems hampered as well by the limitations on one's ability to emote online. (page 5, third paragraph)

Sending E-mail is a solitary endeavor, bereft of the opportunity to engage the parties in a therapeutic conversation and to listen to and understand their concerns, emotions and feelings. **To the extent that this is an important value of the mediation process, online mediation could not accomplish it.** (page 5, fourth paragraph, emphasis added)

The claims about the benefits of electronic distance amount to blatant double-talk. ... using E-mail isolates the participants from one another. (page 6, first paragraph)

Moreover, in making the assumption that introspection may be desirable, proponents are inappropriately considering "thoughtful" reflections to be more valuable than instinctive articulations of emotion or anger. Removing the ability to articulate in the moment might prevent participants from making spontaneous proposals about issues in dispute, and would disadvantage those participants who are not introspective. (page 6, last paragraph)

[I]t would be an unwarranted arrogation of decision-making authority if an online mediator deliberately suppressed expressions of anger or emotion in order to promote "constructive" responses. (sentence bridging pages 6-7)

Like a listserv moderator, the mediator would believe it to be her responsibility to filter out messages that would tend to derail the proceeding, such as messages expressing anger, emotion, or bias. (page 14, first paragraph)

Eisen notes that online mediation could be very costly due to consuming computer resources, higher costs of researching and articulating one's position in textual form, and more mediator time needed to review submissions in their entirety (page 10, first paragraph).

## 2.3.2 DISTINCTIONS BETWEEN EISEN AND THE PRESENT INVENTION

Eisen discloses a completely manual dispute resolution process. Automation is used simply as an e-mail communication channel between the parties, to avoid the need for a face-to-face meeting.

Eisen repeatedly explains that online mediation is a poor substitute for the emotional interactions of face-to-face mediation, stating that online mediation plainly cannot accomplish some of the emotional goals of mediation.

### 2.3.2.1 DISTINCTIONS BETWEEN EISEN AND CLAIM 46

Eisen fails to disclose or suggest the step of providing selected data to the complainer, the selected data being chosen from data previously received from a complaineer based on the initial information from the complainer, as specifically recited in claim 46. Instead, Eisen assumes that a human mediator will ensure that the complaineer tells the complainer of data relevant to complaint resolution. In short, Eisen fails to disclose automating complaint resolution as required in claim 46, and instead teaches that online mediation is not practical until technology can replicate face-to-face interactions.

### 2.3.2.2 DISTINCTIONS BETWEEN EISEN AND CLAIM 55

Eisen fails to disclose or suggest receiving emotional state information from a complainer and including the emotional state information in the complaint, as required by claim 55. Instead, Eisen criticizes the inability of an online process to enable the process values of mediation relating to emotional communication.

## 2.4 THIESSEN

U.S. Patent No. 5,495,412 (Thiessen) was used in rejections of claims 85-89.

#### 2.4.1 DESCRIPTION OF THIESSEN

Thiessen discloses a system that assists multi-party negotiations (column 3, lines 11-15). A set of issues is defined and agreed upon by the parties (column 6, lines 2-15). Then each party inputs its preferences – a range of decision values -- on the issues to confidential system files (column 6, lines 16-30). Based on the preferences, Thiessen's system uses a linear programming algorithm to propose alternative solutions to the parties (column 8, lines 46-49). The system is useful because it has confidential information (column 12, line 55 – column 12, line 2).

#### 2.4.2 DISTINCTIONS BETWEEN THIESSEN AND THE PRESENT INVENTION

Thiessen's system functions as an elaborate calculator. Thiessen assumes that the parties are negotiating directly with each other, such as to agree on what the issues are. Thiessen is not concerned with automating the negotiation process.

##### 2.4.2.1 DISTINCTIONS BETWEEN THIESSEN AND CLAIM 85

Thiessen fails to disclose or suggest choosing at least one selected remedy from a predetermined set of remedies from a complaine based on the information from the complainer, as specifically recited in claim 85. Consequently, Thiessen further fails to disclose or suggest suggesting the at least one selected remedy to the complainer, receiving a response to the at least one suggested remedy, and preparing a complaint is prepared based on the information and the response received from the complainer, as also required by claim 85. In contrast to the claimed requirement of selecting from a predetermined set of remedies, Thiessen creates suggested remedies using a linear programming algorithm based on confidential preference information.

#### 2.5 CHARGEBACK SYSTEMS

Applicant disclosed a chargeback system to the Patent Office (Information Disclosure Statement mailed June 29, 2000, PTO Form 1449 Reference CE, Card Systems eCardSMART Exceptions Management System Press Release February 9, 2000). Applicant believes that

chargeback systems are closer to the present invention than the references relied upon by the Examiner. To ensure proper consideration of the present invention, applicant takes this opportunity to describe chargeback systems and distinguish them from the present invention.

Applicant believes that a chargeback system is a type of assisted negotiation system.

#### 2.5.1 DESCRIPTION OF CHARGEBACK SYSTEMS

Credit card associations, such as Visa and Mastercard, require that their member banks provide cardholders with an opportunity to contest responsibility for a merchant's item on the cardholder's monthly statement. This opportunity to contest is required by Federal law. A chargeback is a formal notice that the cardholder has contested an item on the cardholder's monthly statement; the notice is provided from the cardholder's bank to the merchant's bank.

According to procedures of the credit card associations, after a merchant bank receives a chargeback, the merchant can submit evidence within a predetermined time proving that the item was charged by the cardholder. The merchant's bank provides such evidence to the cardholder's bank. Via the banks, the cardholder has an opportunity to reply to the merchant's evidence, and the merchant has an opportunity to reply to the cardholder's reply. If the dispute persists and is over a predetermined amount, such as \$500, the dispute is referred to arbitrators employed by the credit card association. The cardholder's bank and the merchant's bank participate in the arbitration. The cardholder and merchant are not allowed to participate in the arbitration.

Banks with a large number of cardholders typically use a chargeback system. When the cardholder calls the cardholder bank's customer service telephone number or writes to the bank's customer service center to contest an item, a bank customer service agent invokes the chargeback system. The chargeback system prompts the agent to obtain information from the cardholder about the dispute. The chargeback system includes all of the predetermined problem codes defined by the credit card association, and requires that the agent select one of the problem codes. The chargeback system then prepares a chargeback record identifying the cardholder, merchant, item, selected problem code and possibly other information such as images or text information, and forwards the chargeback record to the merchant's bank via a credit card association communication network.

The chargeback system keeps track of deadlines relating to each dispute, and notifies the customer service agent accordingly.

## 2.5.2 DISTINCTIONS BETWEEN CHARGEBACK SYSTEMS AND THE PRESENT INVENTION

One difference between chargeback systems and the present invention is that chargeback systems assume that a customer service agent will be entering data on behalf of a complainer, whereas the present invention may be used directly by the complainer.

Another difference is that use of the present invention enables a merchant to avoid the chargeback process, and the chargeback fees assessed by the merchant's bank, because the merchant is interacting with its customers via the system of the present invention.

Chargeback systems are for automating the chargeback procedures of credit card associations, not for directly resolving disputes, i.e., a person of ordinary skill in the art of chargeback systems would comply with the chargeback procedures and would not modify them. The credit card association procedures are configured to comply with Federal law, so it would not be obvious to the credit card association to modify its chargeback procedures to do other than comply with Federal law. Federal law is intended to protect consumers from being trapped by credit card bank errors, not to resolve consumer disputes.

In short, applicant believes that it is not obvious to modify a regulatory compliance system to function as a dispute resolution system.

### 2.5.2.1 DISTINCTIONS BETWEEN CHARGEBACK SYSTEMS AND CLAIM 46

Chargeback systems fail to disclose or suggest the step of providing selected data to the complainer, the selected data being chosen from data previously received from a complaine based on the initial information from the complainer, as specifically recited in claim 46. Instead, chargeback systems follow the credit card association chargeback procedures, which require giving the merchant an opportunity to contest the chargeback.

2.5.2.2        DISTINCTIONS BETWEEN CHARGEBACK SYSTEMS AND CLAIM 55

Chargeback systems fail to disclose or suggest receiving emotional state information from a complainer and including the emotional state information in the complaint, as required by claim 55. Instead, chargeback systems are concerned with automating the procedures mandated by credit card associations, which are not based on the emotional state of the cardholder.

2.5.2.3        DISTINCTIONS BETWEEN CHARGEBACK SYSTEMS AND CLAIM 85

Chargeback systems fail to disclose or suggest choosing at least one selected remedy from a predetermined set of remedies from a complaine based on the information from the complainer, as specifically recited in claim 86. It is applicant's understanding that the chargeback systems define the remedies required for all possible credit card chargeback situations. Since the credit card associations have defined the remedies, and required merchants to comply with the association chargeback procedures, one of ordinary skill in the art would not be motivated to define a set of merchant remedies.

3.        THE PRESENT INVENTION IS NOT OBVIOUS OVER THE CITED REFERENCES

Obviousness under 35 U.S.C. 103 is a question of law based on the underlying factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 15 L.Ed.2d 545, 86 S.Ct. 684, 148 U.S.P.Q. (BNA) 459 (1966): (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) objective evidence of secondary considerations. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986), *cert. den.* 484 U.S. 823 (1987).

3.1        OBVIOUSNESS INQUIRY (1): THE SCOPE AND CONTENT OF THE PRIOR ART

The present invention is within the field of automated assisted negotiation systems, that is, systems which do not require a human to control the negotiation process.

Chargeback systems, while assuming the presence of a customer service agent, do not expect the agent to control the processing. Chargeback systems use a customer service agent primarily as a data enterer.

Sloo's system does not require a human to control communications between the complainer and complaine.

### 3.1.1 ISSUE 1: ARE ONLINE RESOLUTION AND EISEN WITHIN THE SCOPE OF THE PRIOR ART?

To determine whether a reference is within the scope and content of the prior art, first determine if the reference is within the field of the inventor's endeavor. If it is not, then next consider whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986), *cert. den.* 484 U.S. 823 (1987).

As explained in detail below, Online Resolution and Eisen fail each of the two prongs of the test of whether they are in the prior art for purposes of an obviousness determination. Thus, there is no proper combination of Sloo and either of Online Resolution and Eisen.

The two prong test for whether a reference is within the prior art, for an obviousness determination, has been applied in many cases.

In *Wang Laboratories, Inc. v. Toshiba Corporation*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993), the invention was a single in-line memory module (SIMM) having eight data memory chips capable of storing 8-bit binary words and also including a ninth chip that functions as a check or parity bit for error detection, packaged in plastic leaded chip carriers mounted on a single epoxy-glass printed circuit board substrate. The cited art was a SIMM containing eight memory chips for storing data and one for error detection, mounted in a single row and encapsulated in ceramic dual in-line packages mounted on an epoxy-glass printed circuit board substrate. In the first prong of the test, the Court found that the cited art is not in the same field as the invention, because the cited art involved memory circuits in which modules of varying sizes could be added or replaced; in contrast, the invention taught compact modular memories. In the second prong of the test, the Court held that the cited art was not reasonably



pertinent because the cited art was applied in large, costly industrial controllers while the invention was applied in small, low cost personal computers.

In *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992), the invention was a process for storing refined liquid hydrocarbon product in a storage tank having a dead volume between the tank bottom and its outlet port, the dead volume having a gelation solution placed therein. The cited art disclosed a process for reducing the permeability of hydrocarbon-bearing formations using a gel similar to the gel of the invention. In the first prong of the test, the Court found that the cited art is not in the same field as the invention because the field of the invention is the storage of refined liquid hydrocarbons whereas the field of the cited art is the extraction of crude petroleum. In the second prong of the test, the Court held that the purposes of the invention and cited art were important in determining pertinency, that the problem of the invention was preventing loss of stored product to tank dead volume while preventing contamination of such product, and that the problem of the cited art, recovering oil from rock, was not pertinent to the invention's problem.

#### ARGUMENT 1A: ONLINE RESOLUTION AND EISEN ARE NOT WITHIN THE FIELD OF THE INVENTOR'S ENDEAVOR.

Each of Online Resolution and Eisen expects a mediator to control communications between a complainer and complaine. Accordingly, Online Resolution and Eisen are not within the field of the inventor's endeavor.

#### ARGUMENT 1B: EVEN IF ONLINE RESOLUTION AND EISEN ARE CONSIDERED TO BE WITHIN THE FIELD OF THE INVENTOR'S ENDEAVOR, THEY ARE NOT REASONABLY PERTINENT TO THE PARTICULAR PROBLEM WITH WHICH THE INVENTOR WAS INVOLVED.

Online Resolution and Eisen are each concerned with making a mediator more effective. This is a different goal than helping a complainer and a complaine negotiate with each other. Making a mediator more effective is not reasonably pertinent to facilitating negotiation between a complainer and complaine, because a mediator can be assumed to be knowledgeable in the dispute resolution process, whereas most complainers and complaines are unlikely to be versed

in dispute resolution and so need a system that provides process guidance. Accordingly, Online Resolution and Eisen are not pertinent to the problem addressed by the present invention.

### 3.2 OBVIOUSNESS INQUIRY (2): THE DIFFERENCES BETWEEN THE PRIOR ART AND THE CLAIMS AT ISSUE

The court must view the claimed invention as a whole. .... We add, as a cautionary note, that the district court appeared to distill the invention down to a "gist" or "core," a superficial mode of analysis that disregards elements of the whole. It disregarded express claim limitations ...  
*Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986), *cert. den.* 484 U.S. 823 (1987).

In the instant application, the Examiner attempted to dismiss portions of the claims as being merely non-functional descriptive matter. This is an improper disregard of express claim limitations.

#### 3.2.1 ISSUE 2: IS IT PROPER FOR THE EXAMINER TO IGNORE A CLAIM LIMITATION AS BEING NON-FUNCTIONAL DESCRIPTIVE MATTER?

The Office Action states, at page 7 (emphasis added),

Sloo does not expressly disclose that the data provided to the complainant is previously received from a complainee or that it relates to a complaint handling policy. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps of simply receiving data from a complainee and providing the data to the complainant would be performed the same regardless of the type of data or source of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). The only functional step recited in the claim relates to preparing the complaint based on information provided from the complainant since the data provided by the complainant is functionally involved in the preparation of the complaint. In other words, a process takes place to specifically act upon the data provided by the complainant in order to prepare a complaint. This functional step, however, is taught by Sloo as discussed above. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to receive from a complainee any type of data and provide the data to a complainant because such data does not functionally relate to the steps in the method claimed and because **the subjective interpretation of the data** does not patentably distinguish the claimed invention.

ARGUMENT 2: CASE LAW REQUIRES THAT ALL CLAIM LIMITATIONS BE  
CONSIDERED.

The court must view the claimed invention as a whole. ... the district court appeared to distill the invention down to a “gist” or “core,” a superficial mode of analysis that disregards elements of the whole. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986) , *cert. den.* 484 U.S. 823 (1987).

In *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983), the invention was a ring, preferably an endless loop of paper or fabric, having digits imprinted thereon, the digits computed according to a particular algorithm, to display various aspects of number theory. The Court held:

Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole. ...

Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. ...

A functional relationship of the precise type found by the CCPA in *Miller* – to size or to type of substrate, or conveying information about the substrate – is not required. What is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship without further analysis, is not dispositive of obviousness.

Claim 46 calls for choosing selected data from data previously received from a complaine based on the initial information from the complainer, and providing the selected data to the complainer. Sloo does not show or suggest choosing selected data from data previously received from a complaine. The nature of the data is not crucial. *Gulack* requires that the Examiner consider this limitation, not dismiss it as irrelevant simply because the selected data is only presented to the complainer, rather than being processed by the system. Claim 46 presents a

functional relationship in that the system chooses which of the data supplied from the complainee to present to the complainer based on the initial information from the complainer.

In *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994), the invention was a memory having a data structure including attribute data objects (ADOs) that comprise sequences of bits containing information used by an application program and information regarding the ADO's relationship with other ADOs. The Court, citing *Gulack*, noted

[The Court of Customs and Patent Appeals], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated.

The *Lowry* Court went on to explain that

The printed matter cases have no factual relevance where “the invention as defined by the claims *requires* that the information be processed not by the mind but by a machine, the computer.”

Claim 46 recites processing by a computer, namely, choosing selected data from data previously received from a complainee. The activity, performed by a computer, of choosing is sufficient computer processing to render the printed matter cases irrelevant. Accordingly, it is improper for the Examiner to dismiss the claimed selected data as mere descriptive matter.

### 3.2.2 ISSUE 3: IS IT PROPER TO CITE A REFERENCE FOR WHAT IT TEACHES AWAY FROM?

The Examiner cited Eisen as curing Sloo's deficiency of a lack of teaching of collecting emotional state information from a complainer. However, in view of Eisen's extensive teachings of the inadequacy of online mediation, it is not proper to cite Eisen for what it teaches away from.

In *In re Wesslau*, 353 F.2d 238, 147 USPQ 391 (CCPA 1965), the Court explained:

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

In *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir. 2000), *cert. den.* 2000 US LEXIS 4144 (2000), the Court stated,

[I]f Johnson did in fact teach away from Moore, then that finding alone can defeat Wang's obviousness claim. ... A "reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the results sought by the applicant." In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

*Gurley* continues that in general, a reference that teaches away cannot serve to create a prima facie case of obviousness. However, in *Gurley*, the reference's teaching was considered because it was described as merely somewhat inferior for the same use as the claimed invention.

The Eisen reference does not teach collecting emotional state information in a system lacking a mediator. The Eisen reference teaches that emotions are an important part of the mediation process, that emotions cannot be properly conveyed in e-mail, and so online mediation will not live up to its promotions. To be usable for what it teaches away from, Eisen would have to present the teaching for the same use as in the claimed invention, which Eisen does not do. Accordingly, the Examiner's use of Eisen was improper.

4. DETAILED RESPONSE TO THE OFFICE ACTION

4.1 PARAGRAPH 8

In paragraph 8 of the Office Action, claim 46 was rejected under 35 USC 112, second paragraph, as being indefinite, for its recitation of “if any” in line 5.

Claim 46 has been amended to eliminate the recitation of “if any”.

Withdrawal of the rejection of claim 46 under 35 USC 112, second paragraph, is requested.

4.2 PARAGRAPH 10

In paragraph 10 of the Office Action, claims 46-63 and 82-89 were rejected under 35 USC 101 as being directed to non-statutory subject matter.

Each of independent claims 46, 55, 82 and 85 has been amended to recite that the actions performed automatically are performed at or by a computer. The actions of a computer are statutory subject matter.

Withdrawal of the rejection of claims 46-63 and 82-89 under 35 USC 101 is requested.

4.3 PARAGRAPH 12

In paragraph 12 of the Office Action, claims 46, 48, 50, 52, 53, 54 were rejected under 35 USC 103(a) over U.S. Patent No. 5,895,450 (Sloo) in view of an Online Resolution Press Release, “Online Mediation Offered for Resolving E-Commerce Disputes” (“Online Resolution”).

As explained in section 3.1.1, Online Resolution fails each of the two prongs of the test of whether it is in the prior art for purposes of an obviousness determination. Thus, there is no proper combination of Sloo and Online Resolution.

As explained in sections 2.1.2.1 and 2.2.2.1, each of Sloo and Online Resolution fails to disclose or suggest the step of providing selected data to the complainer, the selected data being chosen from data previously received from a complaineer based on the initial information from

the complainer, as specifically recited in claim 46. Accordingly, even if the cited references are combined, they do not suggest the invention of claim 46.

Claims 48, 50, 52, 53, 54, in depending from claim 46, incorporate all of the parent claim's limitations and are patentably distinguishable from the cited references for the reasons set forth with respect to the parent claim.

Withdrawal of the rejection of claims 46, 48, 50, 52, 53, 54 under 35 USC 103(a) is requested.

#### 4.4 PARAGRAPH 13

In paragraph 13 of the Office Action, claims 47, 55, 56, 57, 58, 61, 62, 63 were rejected under 35 USC 103(a) over Sloo in view of Online Resolution and Eisen, "Are We Ready for Mediation in Cyberspace".

As explained in section 3.1.1, each of Online Resolution and Eisen fails each of the two prongs of the test of whether it is in the prior art for purposes of an obviousness determination. Thus, there is no proper combination of Sloo and either of Online Resolution and Eisen.

As explained in sections 2.1.2.1, 2.2.2.1 and 2.3.2.1, each of Sloo, Online Resolution and Eisen fails to disclose or suggest the step of providing selected data to the complainer, the selected data being chosen from data previously received from a complaineer based on the initial information from the complainer, as incorporated in claim 47. Accordingly, even if the cited references are combined, they do not suggest the invention of claim 47.

As explained in sections 2.1.2.2, 2.2.2.2 and 2.3.2.2, each of Sloo, Online Resolution and Eisen fails to disclose or suggest receiving emotional state information from a complainer and including the emotional state information in the complaint, as required by claim 55.

Claims 56, 57, 58, 61, 62, 63, in depending from claim 55, incorporate all of the parent claim's limitations and are patentably distinguishable from the cited references for the reasons set forth with respect to the parent claim.

Withdrawal of the rejection of claims 47, 55, 56, 57, 58, 61, 62, 63 under 35 USC 103(a) is requested.

4.5 PARAGRAPH 14

In paragraph 14 of the Office Action, claim 49 was rejected under 35 USC 103(a) over Sloo in view of Online Resolution, Eisen and Brownell, "Say It Right".

Brownell was cited for its disclosure of the use of first person language. Brownell is an article on effective interpersonal communication.

Brownell is not within the field of automated assisted negotiation systems, that is, systems which do not require a human to control the negotiation process. Thus, Brownell fails the first prong of the two prong test for determining whether it is in the prior art for purposes of an obviousness determination.

Brownell is not reasonably pertinent to the field of the invention because it is solely concerned with improving a human's interpersonal skills with another human. This is not pertinent to the field of an automated negotiation system. The goal of improving a human's interpersonal skills is different than the goal of building a more effective computer system.

Since Brownell is not in the prior art, for purposes of an obviousness determination, there is no proper combination Sloo and Brownell. Thus, there is no proper combination of the cited references.

Each of the references fails to show or suggest the step of providing selected data to the complainer, the selected data being chosen from data previously received from a complaineé based on the initial information from the complainer, as incorporated in claim 49. Accordingly, even if the cited references are combined, they do not suggest the invention of claim 49.

Withdrawal of the rejection of claim 49 under 35 USC 103(a) is requested.

4.6 PARAGRAPH 15

In paragraph 15 of the Office Action, claim 51 was rejected under 35 USC 103(a) over Sloo in view of Online Resolution, Eisen and U.S. Patent No. 6,154,753 (McFarland).

McFarland was cited as teaching a method for entering customer complaints into its system, wherein the complaint form is saved with an indication of when follow up with the customer is needed.



McFarland relates to a quality standards document control system, and is not within the field of the present invention, therefore failing the first prong of the two prong test for determining whether it is in the prior art for purposes of an obviousness determination.

The problem solved by a document control system, namely, disorganized documents, is different than the problem solved by the present invention, namely, facilitating dispute resolution. Thus, McFarland is not reasonably pertinent to the field of the present invention, and fails the second prong of the two prong test.

Since McFarland is not in the prior art, for purposes of an obviousness determination, there is no proper combination Sloo and McFarland. Thus, there is no proper combination of the cited references.

Each of the references fails to show or suggest the step of providing selected data to the complainer, the selected data being chosen from data previously received from a complaineer based on the initial information from the complainer, as incorporated in claim 51. Accordingly, even if the cited references are combined, they do not suggest the invention of claim 51.

Withdrawal of the rejection of claim 51 under 35 USC 103(a) is requested.

#### 4.7 PARAGRAPH 16

In paragraph 16 of the Office Action, claim 59 was rejected under 35 USC 103(a) over Sloo in view of Online Resolution, Eisen and Brownell, "Say It Right".

As explained in sections 3.1.1 and 4.5, each of Online Resolution, Eisen and Brownell fails each of the two prongs of the test of whether it is in the prior art for purposes of an obviousness determination. Thus, there is no proper combination of Sloo and any of Online Resolution, Eisen and Brownell.

Each of Sloo, Online Resolution, Eisen and Brownell fails to disclose or suggest receiving emotional state information from a complainer and including the emotional state information in the complaint, as incorporated by claim 59. Accordingly, even if the cited references are combined, they do not suggest the invention of claim 59.

Withdrawal of the rejection of claim 59 under 35 USC 103(a) is requested.

4.8 PARAGRAPH 17

In paragraph 17 of the Office Action, claim 60 was rejected under 35 USC 103(a) over Sloo in view of Online Resolution, Eisen and McFarland.

As explained in sections 3.1.1 and 4.6, each of Online Resolution, Eisen and McFarland fails each of the two prongs of the test of whether it is in the prior art for purposes of an obviousness determination. Thus, there is no proper combination of Sloo and any of Online Resolution, Eisen and McFarland.

Each of Sloo, Online Resolution, Eisen and McFarland fails to disclose or suggest receiving emotional state information from a complainer and including the emotional state information in the complaint, as incorporated by claim 60. Accordingly, even if the cited references are combined, they do not suggest the invention of claim 60.

Withdrawal of the rejection of claim 60 under 35 USC 103(a) is requested.

4.9 PARAGRAPH 18

In paragraph 18 of the Office Action, claims 85, 88, 89 were rejected under 35 USC 103(a) over Sloo in view of U.S. Patent No. 5,495,412 (Thiessen).

As explained in sections 2.1.2.3 and 2.4.2.1, each of Sloo and Thiessen fails to disclose or suggest choosing at least one selected remedy from a predetermined set of remedies from a complaine based on the information from the complainer, as specifically recited in claim 85. So, there is no proper combination of the cited references which makes claim 85 obvious.

Claims 88 and 89, in depending from claim 85, each incorporate all of the parent claim's limitations and are patentably distinguishable from the cited references for the reasons set forth with respect to the parent claim.

Withdrawal of the rejection of claims 85, 88, 89 under 35 USC 103(a) is requested.

4.10 PARAGRAPH 19

In paragraph 19 of the Office Action, claim 86 was rejected under 35 USC 103(a) over Sloo in view of Thiessen and Eisen.

As explained in section 3.1.1, Eisen fails each of the two prongs of the test of whether it is in the prior art for purposes of an obviousness determination. Thus, there is no proper combination of Sloo and Eisen.

Each of Sloo, Thiessen and Eisen fails to disclose or suggest choosing at least one selected remedy from a predetermined set of remedies from a complainee based on the information from the complainer, as incorporated in claim 86. So, there is no proper combination of the cited references which makes claim 86 obvious.

Withdrawal of the rejection of claim 86 under 35 USC 103(a) is requested.

4.11 PARAGRAPH 20

In paragraph 20 of the Office Action, claim 87 was rejected under 35 USC 103(a) over Sloo in view of Thiessen and McFarland.

As explained in section 4.6, McFarland fails each of the two prongs of the test of whether it is in the prior art for purposes of an obviousness determination. Thus, there is no proper combination of Sloo and McFarland.

Each of Sloo, Thiessen and McFarland fails to disclose or suggest choosing at least one selected remedy from a predetermined set of remedies from a complainee based on the information from the complainer, as incorporated in claim 87. So, there is no proper combination of the cited references which makes claim 87 obvious.

Withdrawal of the rejection of claim 87 under 35 USC 103(a) is requested.

5. CONCLUSION

All of the claims of the instant application are believed to be in condition for allowance.

Early and favorable consideration of this application is earnestly solicited. The Examiner is invited to call the undersigned should there be any questions or issues.

Respectfully submitted,

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